

**REMARKS**

The Applicant acknowledges, with thanks, receipt of the Office Action mailed November 19, 2003. Claims 1-30 were pending. Claim 1 was rejected under 35 U.S.C. § 112 for lack of antecedent basis, claims 1-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Knodt et al. U.S. Patent No. 5,124,731 in view of Desmond et. al U.S. Patent No. 5,991,516.

The action by the Examiner of this application and the cited references have been given careful consideration.

**The Subject Application**

By way of review, the subject application teaches a method and system for processing a print job with multiple pages sent from a computer workstation over a computer network. A control unit on the printer directs the printer to get a sheet of paper from a first source for a top cover. The control unit then determines the format of the top cover sheet, i.e., one-sided, two-sided, blank, etc. Next, the control unit directs the printer to obtain one or more subsequent sheets of paper from a second paper source. The printer then prints the remainder of the document using the subsequent sheets of paper. The remainder of the document is typically simplex printing. The control unit then directs the printer to obtain another sheet of paper from the first source for a back cover of the document. The printer then prints the last page of the document on the sheet of paper, either front face, back face, or both faces.

**The Knodt Patent**

In contrast to the subject application, Knodt is directed to a stand-alone, that is non-networked, electronic reprographic system capable of producing cover sheets for an output document set. The system enables a user to select the features desired for the front and back cover sheets. A scanner scans the original document set and stores the document set on the system. The stored electronic images are then reordered to produce front and back cover sheets

with the user selected features. The reordered images are then output, via a printer, including the front and/or back cover sheets.

The stand-alone electronic reprographic system may use a variety of output media, varying in sheet size, types and colors. The varying sheets may be drawn from a main paper tray or an auxiliary tray. A user-interface, coupled to the electronic reprographic system includes a combined controller/display, enabling a user to program print jobs and other instructions. The programming includes the ability to designate cover sheet options for a particular print job. Using the user-interface, an operator may select one of four possible cover printing options. Icons are presented on the controller/display enabling the user to select printing on the front of the front cover sheet, printing on both sides of the front cover sheet, printing on the front of the back cover sheet, and printing on both sides of the back cover sheet. The option to leave the front, back or both cover sheets blank is also provided to the user via the user-interface on the controller/display.

### **The Desmond Patent**

In contrast to the subject application, Desmond is directed to a method of burst printing for a printing apparatus. The method begins with the submission of discrete page images in a pre-determined order to the printing apparatus. A series of page images are identified that form a series, or burst, of page images that can be printed by the printer without having to reconfigure the printer settings. The printer then requests the first burst from memory and outputs the first burst pages. Only after the first burst has finished printing does the printer request the second burst pages for printing.

A burst of page images are a sequence of pages to be output by the printer, with each of the pages having the same general physical configuration, i.e., size of sheet, type of paper, color, one-sided, two-sided, etc. The burst ends when the system recognizes that the next page in the series of page images representing a document has a different physical configuration. The burst concept may be used in preparing stapled documents, wherein a series of pages are surrounded by

two covers, a beginning cover and an end cover. The method taught in Desmond would have all the burst pages printed before moving to a different tray for the cover sheets.

**35 U.S.C. § 112 Rejections**

Claim 1 was rejected under Section 112 as having a limitation lacking antecedent basis. The Examiner's observation is appreciated and Applicant has amended claim 1, thereby removing the basis for this rejection.

**35 U.S.C. § 103(a) Rejections**

Claims 1-30 were rejected as being obvious by Knodt in view of Desmond. Applicant respectfully disagrees.

As discussed above, the system disclosed in Knodt relates to a document reprographic system for producing cover sheets for an output document set. The system enables a user to select the features desired for the front and back cover sheets. A scanner scans the original document set and stores the document set on the system. The stored electronic images are then reordered to produce front and back cover sheets with the user selected features. The reordered images are then output, via a printer, including the front and/or back cover sheets. However, in contrast to the teachings of the subject invention, Knodt does not disclose or suggest the selection of front and back cover sheets from a different tray. }

Contrary to Knodt, each independent claim of the subject application includes the limitation that separate paper sources are used for the cover sheets and the remainder of the document. Independent claim 1 of the subject application contains the limitation that the top cover sheet is from a first paper source and the remainder of the document is printed on paper from a second paper source. Independent claim 8 contains the limitation that the top cover sheet is from a first paper source and the remainder of the document is printed on paper from a second paper source. Independent claim 17 contains the limitation that top cover sheet is obtained from

a first paper source and subsequent sheets of paper for the remainder of the document are obtained from a second paper source. Independent claim 21 contains the limitations of a paper source for covers and a paper source for the remainder of a document. Amended independent claim 25 includes the additional limitations that the cover sheets are obtained from a first paper source and the one or more subsequent sheets of a document are drawn from a second paper source. Independent claim 27 includes the limitations that a cover sheet is printed on a sheet of paper from a cover source and the remainder of the document is printed using paper from a second paper source. As a result of each independent claim containing the limitations of a cover sheet paper source and a document paper source, all dependent claims include the limitations of the independent claim from which they depend. Furthermore, Knodt teaches a stand-alone copy machine, and does not teach or disclose the use of a networked device.

It should be noted that while Desmond describes a tray containing cover stock, Desmond, in fact, teaches away from the subject application. Desmond is directed to burst printing, i.e., fast printing of page images having the same characteristics. Such characteristics include paper stock sources. Desmond teaches a burst manager, residing in an application on a computer network, that controls the burst printing process. The use of burst printing transcends the limitations of a single document or print job. In fact, as Desmond states in Col. 8, lines 11-25, Desmond is solely concerned with the configuration of the printing apparatus, making a printer operate at maximum speed by combining all print jobs, documents, etc., into a single burst of pages to be printed. Desmond states that the burst concept looks only to print pages in a series without having to switch input or output trays. (Col. 6, lines 9-13). Desmond does not teach the limitation of printing a first page on a front face of a sheet of paper and a second page on a second sheet of paper.

In contrast to Desmond, the subject application includes such a limitation in each of the independent claims. Independent claim includes the limitation that a control unit causes a printer to print a first page on a front face of a first sheet of paper and print a second page on a back face

of the first sheet of paper. Independent claim 8 includes the limitation of printing a first page of the document on a front face of the first sheet of paper and print a second page of the document on a back face of the first sheet of paper. Independent claim 17 includes the limitation that a printer will print a first page of the document on a front face of the first sheet of paper and print a second page of the document on a back face of the first sheet of paper. Independent claim 21 includes the limitation of printing a cover on both a front face and a back face of a sheet of paper. Independent claim 25 includes the limitation of a cover being printed on both a front face and a back face of a sheet of paper. Independent claim 27 also includes the limitation of a printer capable of printing a first page of a document on either the front face or the back face of a top cover. Each dependent claim corresponding to the above-identified independent claims include the limitation of printing on both the front and back faces of a sheet of paper.

Similarly, Knodt teaches away from combining with the invention of Desmond. Knodt is directed to a method of printing front and back cover pages on a document reprographic apparatus. Consequently, a combination of the invention disclosed in Desmond with the invention disclosed in Knodt is counter-intuitive. Knodt uses discrete boundaries of document printing, allowing a user to print front and back cover pages. In contrast, Desmond teaches that document boundaries are to be ignored in favor of maximum printer output. Desmond directs that printing need not be stopped or slowed at the end of a document, but rather only changed when it is determined that the configuration of the printer must change.

In contrast to Desmond, each independent claim of the subject application is directed to and claims formatting or printing a single document having discrete boundaries, such as a first page 1 through a last page n, not the burst printing method of ignoring document boundaries. Independent claim 1 includes the limitation that a print job is comprised of a document including a first page 1 through a last page n. Independent claim 8 includes the limitation that a document comprises a first page 1 through a last page n. Independent claim 17 includes the limitation that a document includes a first page 1 through a last page n. Independent claim 21 includes the

limitation that a document comprises a first page 1 through a last page n. Independent claim 25 includes the limitation that a document comprises a first page 1 through a last page n.

Independent claim 27 includes the limitation that a document comprises a first page 1 through a last page n. As each dependent claim depends from one of the above-identified independent claims, the additional limitation of a document comprising a first page 1 through a last page n is incorporated into each dependent claim.

Knodt's use of the user-interface negates the ability to electronically transmit a document from a remote computer over a network to the machine. The user-interface enables the user, while at the reprographic machine, to designate front/back covers. Nothing contained within Knodt suggests or discloses the submission of a document from computer workstation over a computer network, as set forth in the independent claims of the subject application. Thus, as Knodt teaches a reprographic machine not connected to a network nor capable of receiving a print job from a networked computer workstation, there would be no motivation to combine the invention with the Desmond patent. Lacking such a motivation, and the incompatibility of the inventions taught, respectively by Desmond and Knodt, Applicant respectfully traverses the rejections under 35 U.S.C. § 103(a).

## **CONCLUSION**

In view of the foregoing, it is respectfully submitted that all claims are patentably distinct over the art of record and in condition for allowance thereof. If the Examiner believes there are any further matters, which need to be discussed in order to expedite the prosecution of the present application, the Examiner is invited to contact the undersigned.

If there are any fees necessitated by the foregoing communication, please charge such fees to our Deposit Account No. 50-0902, referencing our Docket No. 66329-97295.

Respectfully submitted,

USSN 09/574,553

TUCKER ELLIS & WEST LLP

Date: February 19, 2004

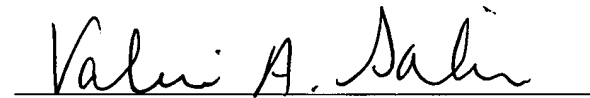


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Date: February 19, 2004



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